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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,404	11/16/2000	Timothy J. Wright	207312	5041

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EXAMINER

IQBAL, KHAWAR

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/714,404	Applicant(s) WRIGHT, TIMOTHY J.	
	Examiner Khawar Iqbal	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3,8-9 and 13 are rejected under 35 U.S.C. 102(e) as being unpatentable by Mizikovsky (20010044296).
3. Regarding claim 1 Mizikovsky teaches a method of allowing a home mobile telecommunications network to authenticate mobile user equipment located in an area covered by a serving mobile telecommunications network, wherein the mobile user equipment has a subscription with the home mobile telecommunications network, the mobile user equipment is adapted to make and receive telephone calls when within an area covered by the home mobile telecommunications network by wireless communication between the mobile user equipment and the home mobile telecommunications network, and the home mobile telecommunications network is operable to generate authentication vectors for allowing the mobile user equipment to make calls by wireless communication between the mobile user equipment and the serving mobile telecommunications network when within the area covered by the serving mobile

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telecommunications network, the method comprising the steps of (figs. 4-5, page 3, para. # 0038-0041):

passing an authentication element forming at least part of an authentication vector, from the serving mobile telecommunications network to mobile user equipment (page 5, para. # 0061-0062),

deciding in the user equipment based at least in part on the value of a predetermined field contained in the authentication element, when to generate a termination message (page 5, para. # 0063-68), and

passing the termination message from the mobile user equipment to the serving mobile telecommunications network, which message contains a value indicating that the serving mobile telecommunications network must obtain a further authentication vector from the home mobile telecommunications network before allowing the user equipment to make further calls (page 5, para. # 0063-68, page 4, para. # 0057-59).

Regarding claim 2 Mizikovsky teaches wherein the termination message, is a predetermined key set identity value (page 5, para. # 0063-68, page 4, para. # 0057-59).

Regarding claim 3 Mizikovsky teaches wherein the predetermined field is an authentication management field (page 5, para. # 0063-68, page 4, para. # 0057-59).

Regarding claim 8 Mizikovsky teaches a method of allowing a home mobile telecommunications network to authenticate A mobile user equipment located in an area covered by a serving mobile telecommunications network,

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wherein the mobile user equipment has a subscription with the home mobile telecommunications network, the mobile user equipment is adapted to make and receive telephone calls when within an area covered by the home mobile telecommunications network by wireless communication between the mobile user equipment and the home mobile telecommunications network and the home mobile telecommunications network is operable to generate authentication vectors for allowing the mobile user equipment to make calls by wireless communication between the mobile user equipment and the serving mobile telecommunications network, the method comprising the steps of (figs. 4-5, page 3, para. # 0038-0041):

requesting service from the serving network to which the user equipment is not directly subscribed (page 4, para. # 0055-0057),

passing the request for service from the serving network to a home operator network to which the user equipment is directly subscribed (page 4, para. # 0059-0060),

generating an authentication vector in the home operator network which includes an authentication management field (page 5, para. # 0059-0060),

passing the authentication management field, contained in an authentication vector, from the home operator network to the serving network (page 5, para. # 0059-0061),

passing an authentication element forming at least part of the authentication vector from the serving network to the user equipment ((page 5, para. # 0061-0062),

extracting in the user equipment the authentication management field from the authentication element (page 5, para. # 0063),

generating in response at least to a predetermined value of the authentication management field, a predetermined key set identifier, and passing the key set identifier to the serving network (page 5, para. # 0063).

Regarding claim 9 Mizikovsky teaches including deciding in the user equipment based at least in part on the value of a predetermined field contained in the authentication element, when to generate a key set identifier which contains a value indicating that the serving network must obtain a further authentication vector before allowing the user equipment to make further calls (page 5, para. # 0063-68, page 4, para. # 0057-59).

Regarding claim 13 Mizikovsky teaches a mobile user equipment for use in a servicing mobile telecommunications network when located in an area covered by a servicing mobile telecommunications network wherein the mobile user equipment has a subscription with a the home mobile telecommunications network the mobile user equipment is adapted to make and receive telephone calls when within an area covered by the home mobile telecommunications network by wireless communication between the mobile user equipment and the home mobile telecommunication network, and the home-mobile telecommunications network is operable to generate authentication vectors for allowing the mobile user equipment to make calls by wireless communication between the mobile user equipment and the servicing mobile telecommunications

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network, the mobile user equipment including (figs. 4-5, page 3, para. # 0038-0041):

means for receiving from the serving network an authentication element forming at least part of an authentication vector (page 5, para. # 0061-0062),

decision means for deciding in the user equipment, based at least in part on the value of a predetermined field contained in the authentication element, when to generate a termination message (page 5, para. # 0063-68), and

means for passing the termination message from the mobile user equipment to the serving network which message contains a value indicating that the serving network must obtain a further authentication vector from the home operator before allowing the user equipment to make further calls (page 5, para. # 0063-68, page 4, para. # 0057-59).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-7, 10-12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky (20010044296) and further in view of Ritter (6543686).

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6. Regarding claim 4-7,10-12,14-16 Mizikovsky teaches a request is transmitted to update (upload) a parameter of a wireless terminal, in response to which an authentication is received from the wireless terminal. The received authentication is forwarded to an authentication center of the wireless terminal, in response to which an authentication response is received from the authentication center. Mizikovsky does not specifically teach wherein the said decision is taken based on the total call duration which has accumulated since the authentication element containing the predetermined field was first received by the mobile user equipment, wherein the said decision is taken based on the time elapsed since ~~the~~ the authentication element containing the predetermined field was first received by the mobile user equipment, wherein the said decision is taken based on the total number of calls made since the authentication element containing the predetermined field was first received by the mobile user equipment and SIM for mobile user equipment embodying.

In an analogous art, Ritter teaches wherein the said decision is taken based on the total call duration which has accumulated since the authentication element containing the predetermined field was first received by the mobile user equipment (col. 4, lines 21-42, col. 5, lines 13-48), wherein the said decision is taken based on the time elapsed since the authentication element containing the predetermined field was first received by the mobile user equipment, wherein the said decision is taken based on the total number of calls made since the authentication element containing the predetermined field was first received by the mobile user equipment (col. 4, lines 21-42, col. 5, lines 13-48, col. 7, lines 35,



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col. 8, lines 23-35), and SIM for mobile user equipment embodying (fig. 1, element 10). Ritter teaches the identification card (10) can be removably inserted into a mobile terminal (1) and contains a data processing device (101) enabling storage of data including user identification data. The card also contains an integrated timer (100), which measures the duration and/or time of use for at least one operation with this card, rating devices (1014), which determine charges depending on the duration and/or time and an interface (12) for an external clock signal enabling synchronization. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Mizikovsky by specifically adding feature in order to enhance system performance of using SIM card of total call duration, time elapsed, and total number of calls made purpose of the limits include limits on total airtime and airtime per call for a specified interval as taught by Ritter.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is 703-306-3015.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **BANKS-HAROLD, MARSHA**, can be reached at 703-305-4379.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2684 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.**

**Khawar Iqbal**

*Marsha D Banks-Harold*

MARSHA D. BANKS-HAROLD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600